

Application No.: 10/579,733
Reply to Office Action dated September 9, 2009

Attorney Docket No. 4035-0180PUS1
Art Unit 2416
Page 8

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-5 are now present in this application. Claims 1 and 5 are independent.

By this Amendment, claim 6 is canceled without prejudice. Reconsideration of this application, as amended, is respectfully requested.

Continued Request to Correct Acknowledgement of Priority Under 35 U.S.C. § 119

Applicants again note that the Office Action Summary (Form PTOL-326) acknowledging a claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document in this national stage Application.. Unfortunately, Applicants have not made such a claim for priority under 35 USC §119(a-d) or (f), as stated in the Office Action Summary. This Application is a national Stage Application filed under 35 USC § 371 of PCT/JP03/14724, which was filed on November 19, 2003, and which does not contain a claim for foreign priority under 35 USC §119(a-d) or (f).

Claim Objection

Claim 6 is objected to as being a substantial duplicate of claim 5. This claim objection is respectfully traversed as moot because claim 6 has been canceled without prejudice.

Accordingly, reconsideration and withdrawal of this objection are respectfully requested.

Personal Interview

Applicants acknowledge with appreciation the courtesies extended by Examiners Jiang and Trost to their representative, Mr. Robert J. Webster, Reg. No, 46,472, during the personal interview held on November 24, 2009. During that interview, it was agreed that claim 1 patentably defines over the applied art of record. Additional dependent claims were also discussed and it was agreed that those claims patentably define over the applied art of record.

Rejections under 35 U.S.C. § 103

Claims 1 and 3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent Application Publication US 24004/0023652 to Shah in view of U.S. Patent Application Publication US 2007/0243821 to Hundscheidt, and further in view of U.S. patent Application Publication US 2005/0154774 to Giaffreda. . This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicants note that Examiner Jiang agreed that the reference to the Srinivasan reference in the body of this rejection is a typographical error and that the Srinivasan reference needs not be addressed in this reply.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under § 103 is whether the claimed invention *as a whole* would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In doing so, the Examiner is expected to make the factual determinations set forth in *Graham v John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *See Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v Delta Resins & Refactories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443,

1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *See In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977,988(Fed. Cir. 2006) (quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

In the sentence just prior to citing the *Kahn* case, the U.S. Supreme Court clearly stated that there has to be an apparent reason to combine the known elements in the manner claimed. The Office has the burden of making out a *prima facie* case of obviousness, i.e., by presenting objective factual evidence of a reason to combine the known elements in the manner claimed. The *KSR* decision did not lift that burden from the Office.

The articulated reasoning has to express a rationale explaining what would have led an ordinarily skilled artisan to combine selected features from each reference in a way that would have resulted in the claimed invention. See, *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Thus, the Supreme Court reaffirmed the fundamental principles set forth in the *Graham v. John Deere Co.* decision, cited and discussed above.

The Office Action readily admits that Shah, the base reference, does not disclose (1) a multicast communication node application processing unit for setting multicast reception using at least the two kinds of wireless communication networks; (2) that the wireless server comprises a home agent application processing unit for setting a multicast transmission using at least the two kinds of the wireless communication networks to a terminal status table; (3) for managing

signaling communication for communicating the status of the respective wireless communication terminals therebetween; (4) and for managing the registration/update processing of the respective wireless communication terminals; and (5) a terminal status table for managing the status of the respective wireless communication terminals.

In an attempt to remedy these admitted deficiencies of Shah, the Office Action turns to (1) Hundscheidt; (2) Giaffreda; and(3) Official Notice.

The Office Action concludes that it would be obvious to implement the teachings of Hundscheidt into Shah because Shah suggests seamless handover for a multi-network radio communication system with the help of GPS, and suggests multicast for a multi-network radio communication system as I is becoming standard in the Third Generation Partnership.

Applicants respectfully disagree and submit that the Office Action fails to provide objective factual evidence in support of the conclusion that one of ordinary skill in the art would be properly motivated to modify Shah in view of Hundscheidt, as suggested, for a number of reasons.

Firstly, Hundscheidt is limited to a distributed caching system and method using mobile clients to cache data content and redistribute the content to other users, so that, if a user does not obtain a transmission from a content provider that was sent to plural users, the user who did not receive that content can query one of the other users, which has cached that content, and obtain the not-received (or defectively received) content from a user who cached that content.

The Office Action fails to explain what Hundscheidt's content caching and

redistribution of the cached content to other users has to do with seamless roaming and is simply not directed to seamless roaming, handover and session continuity between multiple network or peer-to-peer communications, as is Shah.

Hundscheidt's multicast (anycast) scheme is limited to supplying missed/improperly received data using a peer device that has to be independently queried by the peer unit that did not get the content transmitted to it.

Hundscheidt simply does not contain any suggestion to use its multicast scheme to achieve the aforementioned missing features of Shah, i.e., "(3) for managing signaling communication for communicating the status of the respective wireless communication terminals therebetween; (4) and for managing the registration/update processing of the respective wireless communication terminals; and (5) a terminal status table for managing the status of the respective wireless communication terminals."

Accordingly, Applicants respectively submit that one of ordinary skill in the art would have no proper incentive to turn to Hundscheidt to provide the claimed features missing from Shah.

Secondly, Hundscheidt is limited to either the Internet Group Management Protocol (IGMP) or the Neighbor Discovery Protocol, neither of which is utilized by Shah, and does not need to be utilized by Shah for its seamless handover feature.

Thirdly, the Office Action completely fails to explain why the facts that Shah has a seamless handover feature between different communication networks and Hundscheidt has a multicast feature as part of a digital rights management (DRM) content provider

system, why one of ordinary skill in the art would possibly be motivated to modify the seamless handover system of Shah to incorporate a multicast feature that Shah does not need to operate or improve its seamless handover feature. Applicants respectfully submit that one of ordinary skill in the art would have no proper incentive to modify Shah, as suggested, because the added features of Hundscheidt have nothing whatsoever to do with improving Shah's seamless handover feature, and that the only possible reason to suggest this proposed combination of Shah and Hundscheidt is based solely on Applicants' disclosure and constitutes impermissible hindsight.

The Office Action continues by admitting that neither Shah nor Hundscheidt disclose a terminal configuration table for managing wireless communication network interfaces implemented in the respective wireless communication terminals.

In an attempt to remedy this deficiency, the Office Action turns to Giaffreda, which is said to disclose a terminal configuration table for managing wireless communication network interfaces implemented in the respective wireless communication terminals in an analogous radio communication technology.

The Office Action concludes that it would be obvious to implement this teaching of Giaffreda into the Shah-Hundscheidt-Srinivasan reference combination because these three references suggest seamless handover of a wireless control device over multiple networks.

Applicants respectfully disagree with this characterization of the applied references, and respectfully submit that the Office Action does not present objective factual evidence in support of a conclusion that one of ordinary skill in the art would be properly motivated to combine these

references, as suggested, for a number of reasons.

Firstly, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention, including a failure to disclose proper motivation to modify Shah in view of the secondary reference to Hundscheidt for reasons discussed above.

Additionally, Giaffreda is not applied to remedy the aforesaid deficiencies of Shah and Hundscheidt. Thus, even if, solely for sake of argument, one of ordinary skill in the art were properly motivated to modify the base reference combination in view of Giaffreda, as suggested, the so-modified reference combination would not meet, suggest, or otherwise render obvious the claimed invention.

Additionally, as noted above, Examiners Jiang and Trost agreed at the interview held on November 24, 2009, that claim 1 patentable defines over the applied art.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 1 and 3.

Reconsideration and withdrawal of this rejection of claims 1 and 3 are respectfully requested.

Claims 2 and 4 stand rejected under 37 CFR §103(a) as being unpatentable over Shah in view of Hundscheidt and Giaffreda, as applied in the rejection of claims 1 and 3, and further in view of U.S. Patent 6,240,360 to Phelan, and U.S. Patent 6,327,533 to Chou. This rejection is respectfully traversed.

Initially, Applicants note that the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 1, from which claim 2 directly depends and from which claim 4 indirectly depends. Moreover, neither Phelan nor Chou are applied to remedy the aforementioned deficiencies of the reference combination used to reject claim 1. So, even if, solely for sake of argument, one of ordinary skill in the art were properly motivated to modify the base reference combination in view of Phelan and Chou, as suggested, the so-modified version of the base reference combination would not disclose, suggest, or otherwise render obvious the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 2 and 4.

Reconsideration and withdrawal of this rejection to claims 2 and 4 are respectfully requested.

Claims 5 and 6

Claims 5 and 6 stand rejected under 35 USC §103(a) as being unpatentable over Shah in view of Hundscheit and Giaffreda and further in view of U.S. Patent Application Publication 2004/0010615 to Ernst. This rejection is respectfully traversed.

Initially, applicants note that the rejection of claim 6 is moot because claim 6 has been canceled.

Claim 5 recites the subject matter of claim 1, plus additional subject matter, support for which is found throughout this Application as originally filed, including paragraphs [0048] - [0084]

of the publication of the application by the U.S.P.T.O. and is allowable at least because claim 1 patentably defines over the applied art for reasons discussed above, and because Examiners Jiang and Trost indicated that claim 1 patentably defines over the applied art of Shah, Hundscheidt and Giaffreda.

Applicants also note that Ernst, the additional reference applied in this rejection, is not applied to remedy the shortcomings of the Shah-Hundscheidt-Giaffreda reference combination so, even if one of ordinary skill in the art were properly motivated to modify the Shah-Hundscheidt-Giaffreda reference combination as suggested, the so-modified reference combination would still not disclose, suggest, or otherwise render obvious the subject matter of claim 5.

Additionally, Applicants respectfully submit that Ernst uses its multicast service to deliver binding update messages to corresponding nodes to improve bandwidth usage, and not to provide seamless communication. See, for example, the Abstract and the Summary of the Invention paragraphs of Ernst.

For this reason, Applicants respectfully submit that one of ordinary skill in the art would not be properly motivated to turn to Ernst to modify the Shah-Hundscheidt-Giaffreda reference combination to achieve the claimed invention.

Accordingly, reconsideration and withdrawal of this rejection of claims 5 and 6 are respectfully requested.

Application No.: 10/579,733
Reply to Office Action dated September 9, 2009

Attorney Docket No. 4035-0180PUS1
Art Unit 2416
Page 19

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: **DEC 08 2009**

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
Paul C. Lewis

Reg. No.: 43,368
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000
Attorney for Applicants